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Re: Application/Control Number: 09/500,977
Carolyn Bleck, Examiner
Art Unit 3626

Appeal Brief to Final Action

Dear Board of Patent Appeals and Interferences:

I hereby enclose this Appeal Brief, and respectfully request your intervention to reverse the Examiner's final rejection of my claims.

I also hereby enclose a check for $165 as the fee to submit this Appeal Brief.

Please do not hesitate to contact me if you have any questions.

Very truly yours,

James W. Soong

Certificate of Mailing

I, James W. Soong, hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

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APPEAL BRIEF

I. REAL PARTY IN INTEREST

I, James W. Soong, am the sole inventor.

II. RELATED APPEALS AND INTERFERENCES

I am unaware of any appeal or interference that will directly affect, be directly affected by, or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

Claims 21, 23-24, 27-28, and 30-44 are pending. Claims 1-20 were originally presented, Claims 21-44 were added during prosecution, and Claims 1-20, 22, 25-26, and 29 were cancelled during prosecution.

The Final Office Action (Paper Number 14) with a mailing date of March 30, 2004 rejected the claims as follows:[1]

-- Claims 21, 23-24, 27-28, 30-32, and 38-44 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,516,315 to Gupta ("Gupta") in view of U.S. Patent No.

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[1] The Final Action at page 6 states: "Claims 23-24, 27-28, 30-32, and 39-44 have not been amended and are rejected for the same reasons given in the prior Office Action (paper number 4; section 3(A)-3(M); pages 2-10)." The Final Action has repeated reference to "paper number 4". These statements about "paper number 4" have caused me much confusion.

After looking over and over at my files, I am not aware of any "paper number 4" that contains any substantive discussion of my claims. Examiner Bleck is on vacation during the time I am preparing this Appeal Brief. At her automated message's suggestion, I contacted Supervisory Examiner Thomas, who, on the very next day, very graciously and promptly indicated in a voice message that "paper number 4" appeared to be an error and likely referred to paper number 5 or paper number 9.

I had assumed that this "paper number 4" might be a typographical error that should have identified paper number 5. However, three reasons lead me to believe that paper number 5 was not intended. First, the section and page references accompanying "paper number 4" references do not match. For example, paper number 5 does not have a "section 3(A)-3(M)" at "pages 2-10". Second, paper number 9 does seem to match the section and page references. Third, paper number 5 rejects claims that are different than the claims now finally rejected.

This realization makes me assume paper number 9 is the paper intended by the Final Action's reference to "paper number 4". However, I still am not entirely certain because, for example, the Final Action seems to strongly suggest that paper number 9 is one paper, and "paper number 4" a separate paper. At page 9 of the Final Action, Claims 35-36 are rejected under paper number 9 and "[f]urther" by "paper number 4". Adding to the confusion is the Final Action's consistent reference to paper number 9 as the "previous" Office Action and "paper number 4" as the "prior" Office Action in the Final Action on pages 2, 6, 8.

At this point, I will proceed with my best guess that paper number 9 was intended.

6,523,009 to Wilkins ("Wilkins") and U.S. Patent No. 6,322,502 to Schoenberg et al. ("Schoenberg")

-- Claims 33-34 and 37 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,024,699 to Surwit et al. ("Surwit")

-- Claims 35-36 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,024,699 to Surwit et al. ("Surwit") and further in view of U.S. Patent No. 6,208,974 to Campbell et al. ("Campbell")

IV. STATUS OF AMENDMENTS

I have not filed any amendments after the Final Office Action.

V. SUMMARY OF DISCLOSURE

For too long medicine has focused on the needs of doctors, health care professionals, and the medical industry as a whole at the expense of patient needs. The traditional health care industry's static, ingrained focus from the physician's, as opposed to patient's, perspective vests control of patient records in health care professionals and the health care industry. My invention accomplishes a fundamental shift in values and vision for a health care industry indifferent to patient needs and desires.

In recognition that patients deserve better than third-class status, my invention empowers patients to exercise comprehensive control over their own records. Patients, and not their hired service providers such as doctors and health care facilities, control who can electronically access their records by defining access rules. For example, under my invention, the patient can selectively designate one group of individuals to see some of the patient's records and another group of individuals to see other of the patient's records. The designated persons can include personal relations of the patient, medical personnel, financial and billing personnel, and anyone else chosen by the patient. As another example, my invention allows the patient to program the automatic provision of electronic notifications about the patient's status to persons selected by the patient.

My invention is a significant advance over primitive, conventional records systems because my invention enables multi-dimensional records access by all kinds of people, not

exclusively health care providers, in accordance with the special preferences and under the control of patients.

VI. SUMMARY OF PRIOR ART REJECTIONS

A. The Gupta Patent

These are excerpts that quote relevant teachings from Gupta:

"The steps for designing the security system design are:
1. Design a security classification hierarchy that serves the security needs of the organization." 9:14.

"Generally, only high level roles such as system administrator have full access to these objects, and most other system users have read-only access." 6:39-42.

"For example, a patient may have read-only access to his entire folder, but can modify only his bio-data information." 8:30-32.

Similarly, Figure 5 illustrates selective records access to benefit the organization, and also reveals deprivation of access control for patients. Typical of the prior art, Gupta teaches the supremacy of the health care organization at the expense of the patient.

B. The Wilkins Patent

These are excerpts that quote relevant teachings from Wilkins:

"An individualized patient electronic medical records system that provides unlimited patient access to her/his medical records, including text and other data." Abstract.

"Thus, the present invention provides an individualized patient electronic medical records system for unlimited patient access to her/his personal and comprehensive medical records." 3:16-20.

" . . . the comprehensive individual patient medical records 20 are controlled by the patient 22, who has the capability of reading the medical records that are electronically stored on a mobile storage device 20 . . . " 4:53-56.

" . . . the mobile storage device (individual patient records) 20 is a computer-based storage device, e.g.,. CD rom, diskette, tape, etc." 4:63-65.

"However, access to the information by medical care providers and/or insurance providers and administrators, particularly emergency medical care providers, is not impeded by password or other protective means." 3:11-15.

Typical of the prior art, Wilkins teaches that every member of the health care organization has full and complete access to patient records. This access cannot be limited by the patient. While the patient in Wilkins enjoys some personal access to his own records, the patient has no power to allow others to access his records in a manner selectively controlled by the patient.

C. The Schoenberg Patent

These are excerpts that quote relevant teachings from Schoenberg:

"A medical information system receives patient data and information from various sources and displays such information in a variety of formats for use by members of a medical team in a hospital, clinic, or office." Abstract.

"Use of the system in a hospital can effect a significant savings in the time spent by the medical team in reviewing and recording patient information." 6:10-12.

Like the conventional systems, Schoenberg teaches collection and display of patient data for the benefit of the health care organization, not the patient.

D. The Surwit Patent

These are excerpts that quote relevant teachings from Surwit:

"In view of the above discussion, it is an object of the present invention to allow health care providers to quickly and easily monitor many patients simultaneously and to automatically identify patients with medical conditions and to organize identified medical conditions by severity." 2:26-31.

"Data transmitted from a patient monitoring system may be analyzed substantially simultaneously with the transmission thereof . . . to identify emergency medical conditions requiring immediate medical attention." 2:56.

"In response to identifying an emergency medical condition, treatment information may be automatically communicated to the respective patient monitoring system . . . ." 4:8.

"The present invention is advantageous because physicians and other health care providers can remotely monitor, identify, and treat patient medical problems . . . . The present invention facilitates automation of various aspects of patient treatment." 4:13-19.

Surwit deals exclusively with medical conditions in the monitoring, diagnosing, prioritizing, and treating of remotely located patients (Abstract).

E. The Campbell Patent

These are excerpts that quote relevant teachings from Campbell:

Wellness plan administration software provides a user interface to enable users to learn about and select a wellness plan. Abstract.

The central wellness plan administrator analyzes the billing information uploaded from the hospitals and creates the files necessary to obtain payments from a client's bank account or credit card. Specifically, it creates payment files and submits them electronically to the bank. The bank makes all of the individual charges, including both credit card charges and account debits, and makes the deposit directly into the plan administrator's account. 30:65-31:5.

Campbell merely addresses conventional business-to-business communications, and fails to teach the provision of automatic notifications, as decided by patients, to individuals outside the business context, such as patients.

VII. ISSUES

The following issues are presented for review:

A. Is the rejection of Claims 21, 23-24, 27-28, 30-32, and 38-44 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,516,315 to Gupta ("Gupta") in view of U.S. Patent No. 6,523,009 to Wilkins ("Wilkins") and U.S. Patent No. 6,322,502 to Schoenberg et al. ("Schoenberg") proper?

B. Is the rejection of Claims 33-34 and 37 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,024,699 to Surwit et al. ("Surwit") proper?

C. Is the rejection of Claims 35-36 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,024,699 to Surwit et al. ("Surwit") and further in view of U.S. Patent No. 6,208,974 to Campbell et al. ("Campbell") proper?

VIII. GROUPING OF CLAIMS

Claims 21, 23, 24, 28, 30, 32, 38, 39, 40, 41, 44 stand or fall together. These claims recite, among myriad inventive features, the empowerment of the patient to determine access rules to govern selective access to the patient's records by different groups of individuals according to the patient's choosing. For example, the groups may be both health care providers and non health care providers, including a local physician, a physician specialist, and accounting or billing personnel, and the patient himself. The patient can define access rules relating to the roles of the persons desiring access. The claimed invention fundamentally recognizes that a patient should have primary decision-making power over who may access his own records, and over the degree of permitted access.

Claim 27 stands or falls alone. This claim recites the ability of the patient to allow a personal relation, such a family member or friend, to access the patient's records. The claimed invention recognizes that the patient should be empowered to show his records to family, friends, and others concerned, not merely health care personnel or others in the medical industry.

Claim 31 stands or falls alone. This claim recites the ability to, according to patient data parameters, organize and sort records of the patient into a file. The file can be stored and later accessed with ease. The claimed invention recognizes that data organized in a certain manner may be useful many times over in other circumstances, especially if it can be recalled with little effort.

Claims 33, 34, 37 stand or fall together. These claims recite the patient's ability to define a complex threshold event relating to both medical and nonmedical patient data that causes the sending of a notification to a non health care provider selected by the patient. The notification is more than a one-dimensional request to perform medical services or communication about medical conditions. The claimed invention recognizes that the patient may desire to define complex events that trigger notices being sent to a diverse pool of recipients that extend well beyond the health care setting. One possible recipient could be a personal relation of the patient.

Claims 35, 36 stand or fall together. These claims recite a threshold event concerning payments due a health care provider and a related notification requesting that the health care provider be paid. The claimed invention recognizes that threshold events triggering notices should cover the financial condition of the patient, and extend beyond the conventional realm of automatic notices that concern only the physical or medical condition of a sick patient. The notification could be sent to the patient.

Claim 42 stands or falls alone. This claim recites the ability of the patient to provide records access to separate groups of persons based on two criteria regarding the amounts of money owed by the patient. As an example, the patient can provide records access to billing and accounting personnel for records reflecting one criterion and can also provide a financial planner records access to records reflecting another criterion.

Claim 43 stands or falls alone. This claim recites the ability of the patient to provide records access to separate groups of persons based on two criteria regarding the amounts of money owed by the patient. The separate groups are billing and accounting personnel and personal relations of the patient. For example, at their request, the patient may wish to

additionally allow his family members to see especially large medical bills so that the family members can help with such expenses.

IX. ARGUMENTS

A. Legal Requirements of Patentability

In the absence of a proper prima facie case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. See In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992). In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a prima facie case of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992). The Examiner can satisfy this burden only by establishing the following three basic criteria:

> First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or tom combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); MPEP 2142.

1. Hindsight Cannot Be Selectively Employed to Deprecate Claimed Invention

We "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." Ecolochem, Inc. v. Southern Cal. Edison Co., 227 F.3d 1361; 56 U.S.P.Q.2d 1065 (Fed. Cir. 2000); In re Fine, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1988). "Defining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness." Monarch Knitting Mach. Corp. v. Sulzer Morat Gmbh, 139 F.3d 877, 880, 45 U.S.P.Q.2d 1977, 1981 (Fed. Cir. 1998); Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods., Inc., 21 F.3d 1068, 1072, 30 U.S.P.Q.2d 1377, 1379 (Fed. Cir. 1994) ("When the patent invention is made by combining known components to achieve a new system, the prior art must provide a suggestion, or motivation to make such a combination.").

2. References That Teach Away Cannot Be Combined to Reject Claimed Invention

"When there are differences in the teachings between two prior art references, they may teach away from their combination, and result in a finding lacking any motivation to combine and preclude an obviousness claim." See Winner Int'l Royalty Corp. v. Ching-Rong Wang, 202 F.3d 1340 (Fed Cir. 2000).

A "reference will teach away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant." Karsten Mfg. Corp. v. Cleveland Golf Co., 242 F.3d 1376; 58 U.S.P.Q.2d 1286 (Fed. Cir. 2001); In re Gurley, 27 F.3d 551, 553, 31 U.S.P.Q.2d 1130, 1131 (Fed. Cir. 1994). References that teach away from the claimed invention cannot be combined to defeat patentability. Winner International Royalty Corp. v. Wang, 202 F.3d 1340; 53 U.S.P.Q.2d 1580 (Fed. Cir. 2000).

3. When References Are Properly Combined, They Must Produce the Claimed Invention

In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention. Karsten Mfg. Corp. v. Cleveland Golf Co., 242 F.3d 1376; 58 U.S.P.Q.2d 1286 (Fed. Cir. 2001).

B. The Rejection of Claims 21, 23-24, 27-28, 30-32, and 38-44 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,516,315 to Gupta ("Gupta") in view of U.S. Patent No. 6,523,009 to Wilkins ("Wilkins") and U.S. Patent No. 6,322,502 to Schoenberg et al. ("Schoenberg") Is Improper

1. Claims 21, 23, 24, 28, 30, 32, 38, 39, 40, 41, 44

Claim 21 recites "determining access rules to selectively govern access to the component fields by both health care providers and non health care providers, the access rules determined by the patient" and "providing access based on the access rules" depending on whether access is desired by a first group versus a second group of individuals. Likewise, Claim 38 recites "determining access rules to selectively govern access to the component fields, the access rules determined at least in part by the patient" and "providing based on the access rules access to" records depending on the presence of parameters indicative of desired access by groups of

individuals. In both claims, access to records is selectively provided to different people under the control of the access rules determined by the patient. My claimed invention reflects a fundamental shift in values and vision for the industry. My invention significantly advances the health care industry by vesting real power in patients to exercise comprehensive control over and sharing of their own records. Patients, and not their hired service providers, control access to their records by all others.

a. Nothing teaches or motivates the combination of the cited patents Gupta, Schoenberg, and Wilkins except improper hindsight.

There is no teaching or motivation that supports combination of Gupta, Schoenberg, and Wilkins. Gupta teaches the prior art convention of determining selective records access from the perspective of the professional organization exclusively. Gupta unequivocally concerns a "security classification hierarchy that serves the security needs of the organization". 9:14. Likewise, Schoenberg teaches the well known convention of selective records access by the medical team and, in Schoenberg's own words, expressly concerns: "A medical information system receives patient data and information from various sources and displays such information in a variety of formats for use by members of a medical team in a hospital, clinic, or office." Abstract.

In contrast to selective access, an excerpt from Wilkins expressly requires unlimited, unfettered access to records by health care providers and others:

> However, access to the information by medical care providers and/or insurance providers and administrators, particularly emergency medical care providers, is not impeded by password or other protective means. 3:11-15.

Question

> *Can this preceding quote from Wilkins be understood as unimpeded access in emergency situations only, as raised during the interview?*
>
> No. The plain language and context of Wilkins emphasizes unimpeded access for medical care providers (and others) at all times.

Because of fundamental, conflicting differences in the teachings between selective access (Gupta) versus free access (Wilkins) by health care professionals, the references "teach away from their combination, and result in a finding lacking any motivation to combine and preclude an obviousness claim". See Winner Int'l Royalty Corp. v. Ching-Rong Wang, 202 F.3d

1340 (Fed Cir. 2000). Only hindsight supports their combination.[2] Ecolochem, Inc. v. Southern Cal. Edison Co., 227 F.3d 1361; 56 U.S.P.Q.2d 1065 (Fed. Cir. 2000) (forbidding hindsight reconstruction to pick and choose among isolated disclosure in prior art); In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991) (prohibiting use of applicant's disclosure to find teaching or suggestion to make combination of prior art references); In re Dembiczak, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.").

b. The cited patents Gupta, Schoenberg, and Wilkins teach away from my claimed invention

The Gupta (and Schoenberg) and Wilkins patents do not individually or in combination teach my invention, as recited. Although the patents are inconsistent in a fundamental aspect as discussed above, they share one quality: Both patents clearly fail to mention any kind of patient participation in determining records access for others because these patents reflect ingrained industry values driven by the dispositive influence of health care professionals/organizations and not the preferences of their patients.

At its most fundamental level, although Gupta teaches some access control features, Gupta still relegates patients to an inferior status by caring only about "the security needs of the organization" and, worse still, limiting the patient's access to his own records. On page 11 of the Final Action, the Examiner claims that Gupta does not teach away from my claimed invention. However, even in the Final Action at page 5, the Examiner concedes that "Gupta discloses only that an administrator defines the [access] rules".[3] Gupta and my invention are mutually exclusive.

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[2] On page 10 of the Final Action, in response to my objection about hindsight, the Examiner seems to argue that the cited patents need not contain an express statement to motivate the combination of cited patents. However, since Gupta and Schoenberg require limited records access based on security considerations, and Wilkins contrarily teaches unlimited, "unimpeded" records access for medical personnel, how can the cited patents be reconciled?

[3] This statement by the Examiner is confusing because it is apparently contrary to the immediately preceding statement by the Examiner at Final Action on page 5, which says: "Gupta is entirely silent as to the person who determines access rules." I respectfully disagree.

Question

Can the "administrator" discussed in Gupta be somehow equivalent to a "patient", as asserted during interview and asserted again by the Examiner in the Final Action on page 11 ("the Examiner is unable to find anything in the Gupta reference that precludes or 'teaches away from" an ability to allow the administrator of the Gupta method to be a patient")?

No. Gupta clearly uses the terms "administrator" and "system administrator" interchangeably in their ordinary sense to describe the role of an IT person who has "full access" (Figure 5, 6:40) as opposed to the patient who "may have only read-only access to his entire folder" (8:30). It would ignore reality to equate an IT professional employed to manage the information of a health care organization with a patient seeking treatment from the health care organization. To equate a patient with a system administrator (whose exclusive objective as an employee is serving the information technology demands of his employer, the organization) defies common sense.

Wilkins teaches a rather limited recognition that the patient should be able to enjoy some constrained ability to control only those records that are downloaded to a personal "CD rom, diskette, tape, etc." 4:63. Wilkins fails to teach vesting power in the patient to decide who else gets to see his records maintained in the database of the health care organization. In fact, Wilkins expressly requires unbounded access to records by health care providers. The limited teachings in Wilkins disclose exclusive control by health care professionals over medical records to the exclusion of patients. Even in Wilkins, the patient remains subservient in the handling of his own records.

Question

Does Wilkins teach "a patient owned and controlled electronic medical record, wherein the patient determines who has access [sic] the electronic medical record" or "Wilkins's feature of allowing a patient to determine access", as alleged by the Examiner on page 5 of the Final Action?

No. I respectfully must say that the Examiner entirely misreads Wilkins. Here are quotes from Wilkins:

> "An individualized patient electronic medical records system that provides unlimited patient access to her/his medical records, including text and other data." Abstract.
>
> "Thus, the present invention provides an individualized patient electronic medical records system for unlimited patient access to her/his personal and comprehensive medical records." 3:16-20.
>
> " . . . the comprehensive individual patient medical records 20 are controlled by the patient 22, who has the capability of reading the medical records that are electronically stored on a mobile storage device 20 . . . " 4:53-56.

> " . . . the mobile storage device (individual patient records) 20 is a computer-based storage device, e.g.,. CD rom, diskette, tape, etc." 4:63
>
> "However, access to the information by medical care providers and/or insurance providers and administrators, particularly emergency medical care providers, is not impeded by password or other protective means." 3:11-15.

Wilkins teaches the limited concept of allowing a patient to exercise some control over a simple CD rom, diskette, tape, etc. containing his own records. Wilkins does not teach a patient's exercise of discretion over selectively allowing others to access his records. This narrow teaching also does not extend to allowing a patient to program rules limiting who else will be permitted to access to certain of his records in the database of a medical organization, as my invention does. Wilkins clearly states that access by the medical organization is "not impeded".

Question

> *Does Wilkins allow the patient to dictate which medical care professionals get to access the CD rom, diskette, tape, etc., as raised during interview?*
>
> No. As expressly taught by Wilkins at 3:11-15, "access to the information by medical care providers and/or insurance providers and administrators, particularly emergency medical care providers, is not impeded by password or other protective means". In perspective, this question and answer do not bear on my invention except insofar as Wilkins' teachings again reveal the widespread and well-accepted notion that patient control over records are subservient to the unbounded privilege of medical care professionals.

Further, Wilkins concerns patient control over a mere CD rom, tape, diskette, etc. as a static, simplistic store of personal records information. My claimed invention in contrast "electronically handl[es] the records as a plurality of component fields maintained in a database" to execute dynamic "access rules to selectively govern access" by others designated by the patient. The purposes and context of Wilkins versus my invention are completely different.

Gupta (and Schoenberg) and Wilkins teach away from my invention because the line of development flowing from their disclosures (i.e., medical industry is paramount over patient preferences over records access) is exactly contrary to my innovative empowering of the patient regarding records control to the detriment of the medical industry. See Karsten Mfg. Corp. v. Cleveland Golf Co., 242 F.3d 1376, 58 U.S.P.Q.2d 1286 (Fed. Cir. 2001); Winner International Royalty Corp. v. Wang, 202 F.3d 1340; 53 U.S.P.Q.2d 1580 (Fed. Cir. 2000) (holding that when

cited patents teach away from the claimed invention they cannot be combined to defeat patentability).

c. Even if Gupta and Wilkins are somehow be combined, their combined teachings fail to teach the claim limitations of my invention

The combination of these patents would hypothetically teach a records access system that:

> (Gupta and Schoenberg) provides the professional organization selective access to all of the patient's records in accordance with the organization's preferences, and not the patient's, and
>
> (Wilkins) provides the patient (and other health care professionals) an unfettered ability to access to her own records on a personal CD rom, tape, diskette, etc.

No combination of any of the cited patents achieves my invention of allowing a patient to herself selectively determine who else will see her records. For example, my invention allows a patient to naturally permit medical personnel to see only the medical records directly relevant to the care each is providing to the patient. Even further, my invention further allows the patient to specially designate, for example, a favorite physician (e.g., oncologist) to see other records (e.g., relating to his foot injury) that do not directly relate to the services that physician is providing the patient. In combination, the patents clearly fail to teach my invention's claimed limitations of, for example (Claim 21):

- "determining access rules to selectively govern access" to records
- "the access rules determined by the patient"
- "providing access based on the access rules to a first predetermined group of the component fields" for "desired access by a first group of individuals"
- "providing access based on the access rules to a second predetermined group of the component fields" for "desired access by a second group of individuals not identical to the first group of individuals"

The Final Action on page 13 states: "Therefore, the Examiner relied upon Wilkins for teaching a patient owned and controlled electronic medical record, wherein the patient determines who has access [sic] the electronic medical record . . . " This reliance is based on an entirely incorrect understanding of Wilkins. First, Wilkins unremarkably teaches that a patient can access his own records -- there is no disagreement on this minor point. More importantly, however, Wilkins does not teach that the patient can dictate rules controlling records access by

others. Nowhere in Wilkins is this empowerment of the patient taught or suggested. In fact, Wilkins essentially forbids the patient to control access by others:

> "An individualized patient electronic medical records system that provides unlimited patient access to her/his medical records, including text and other data." Abstract.
>
> "However, access to the information by medical care providers and/or insurance providers and administrators, particularly emergency medical care providers, is not impeded by password or other protective means." 3:11-15.

Assuming that their combination is even permissible, the teachings of Gupta, Schoenberg, and Wilkins still cannot be combined "in the way that would produce the claimed invention".[4] Karsten Mfg. Corp. v. Cleveland Golf Co., 242 F.3d 1376, 58 U.S.P.Q.2d 1286 (Fed. Cir. 2001). In re Vaeck, 947 E.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991) ("the prior art reference (or references when combined) must teach or suggest all of the claimed limitations"). The Examiner has failed to make a prima facie case of obviousness, and Claims 21 and 38 are patentable. The other claims are patentable, at least for their dependence on Claims 21 and 38.

2. Claim 27

Claim 27 recites that a "second group of individuals [that] includes a personal relation who is not a medical care provider of the patient" can access the patient's records if the patient so desires. Nowhere does the prior art teach allowing a patient to powerfully provide records access to his personal relations. This is because the prior art reflects the exclusive dominance of medical personnel in designing records access, and entirely failed to comprehend the needs of patients and their desire to share records access with, for example, his brother, his overseas friend, or his family's religious or spiritual leader.

Assuming that paper number 9 is the relevant rejection, I respectfully disagree with the contention of the Examiner on page 7, which seems to argue that the patient disclosed in Gupta who can access his own data is ("reads on") my claimed "personal relation". This defies common

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[4] On page 9 of the Final Action ("Response to Arguments"), the Examiner suggests that I am remiss for looking at the cited patents individually rather than at their combined teachings. This is not true. I have combined their teachings (see main text). The problem is that the combination of the cited patents have glaring holes that fail to cover my claimed invention. The holes in the prior art exist because the cited patents reflect ingrained, conventional thinking to various degrees about the inferiority of patients. Where is there any combined teaching in the prior art to empower patients so they can control who else can view their records?

sense – my invention's claimed "a personal relation . . . of the patient" is not equivalent to the patient himself. My invention as claimed in Claim 27 relates to the provision of the records access by the patient to his personal relations, not to himself. Claim 27 is patentable for want of a prima facie showing of unpatentability by the Examiner.

3. Claim 31

Claim 31 recites "compiling the organized records . . . into an electronic file history that is storable". This inventive feature enables organization and compilation of patient information in a file history so that the organized data in the file history can be saved and conveniently reused "for later access". The claimed invention recognizes that data organized in a certain manner may be useful many times over in other circumstances, especially if it can be recalled with little effort. Paper number 9, and its description of Gupta to reject this claim, fails to address my invention's storable "file history" for later access and convenience posed by the ability to later consult the file history. Thus, the Examiner failed to make a prima facie showing of unpatenability. For these reasons, Claim 31 is patentable.

4. Claim 42

Claim 42 recites "a first set of component fields [that] satisfies a first criterion about monetary amounts owed" accessible by one group of people and "a second set of component fields [that] satisfies a second criterion about monetary amounts owed" by another group of people. My invention provides the ability of the patient to provide granular records access to separate groups of persons based on two criteria defined by the patient regarding the amounts of money owed by the patient. As an example, the patient can provide records access to billing and accounting personnel for only those records that reflect routine amounts owed, and can also provide different records access to his financial planner when medical bills total a large figure that would detrimentally impact the patient's financial long-term retirement strategy. The cited prior art fails to show this inventive feature.

The Examiner's rejection as set forth in paper number 9 on page 9 is not convincing. Schoenberg's discussion of sets and subsets of data is inapposite to my invention. For the sake of argument, the closest, but still unconvincing, analogy of my claimed "monetary amounts owed"

to Schoenberg's teachings appears to be a "subset"[5] that Schoenberg identifies as "patient cost data". 8:16-9:9. In Schoenberg, the subset "patient cost data" is shared with the users categories "insurance coordinator", "finance", and "insurance". These categories of individuals enjoy equal and full access to patient cost data subset. In contrast, the claimed "monetary amounts owed" could be characterized (for purposes of the comparison with Schoenberg) as a "subset" of data. However, my invention contemplates access to one part of that subset to one group under a "first criterion" and access to another different part of that subset to another group under a "second criterion". In other words, my invention provides granular control over information regarding amounts owed and parses that information to different groups, whereas Schoenberg, if it provides access to "patient cost data", provides it equally to all designated groups. Schoenberg fails to teach the granular, more powerful records access that my invention provides.

Accordingly, the cited prior art does not constitute a prima facie showing of unpatentability, and Claim 42 is patentable.

5. Claim 43

Claim 43 recites two groups of individuals allowed to access records about the different monetary amounts owed: "billing or accounting personnel" and "personal relations of the patient". As an example, the patient can provide records access to billing and accounting personnel for records reflecting routine amounts owed and can also provide records access to personal relations for records reflecting large amounts owed. At their request, the patient may wish to allow his family members to see especially large medical bills so that the family members can help to pay such expenses.

The Final Action cites paper number 9 at page 10 as the rationale for the final rejection of this claim. That paper recycles the rejection of Claim 27 (and Claims 40, 41). Accordingly, I renew my arguments with respect to Claim 27. First, I respectfully disagree with the contention of the Examiner on page 7, which seems to argue that the patient disclosed in Gupta who can access his own data is ("reads on") my claimed "personal relation". This defies

[5] The "sets" identified in Schoenberg do not appear to relate to monetary amounts owed. 8:36-41.

common sense – my invention's claimed "a personal relation . . . of the patient" is not equivalent to the patient himself. My invention relates to the provision of the records access by the patient to his personal relations, not to himself. Second, nowhere in Gupta is any teaching that the patient can allow personal relations to access data regarding the amounts of money he owes, much less provide access to both billing personnel as well as personal relations regarding different data concerning money owed. Again, Gupta fails to anticipate the needs of patients because the medical industry drives Gupta's narrow focus.

Claim 43 is patentable for failure to make a prima facie showing of unpatentability by the Examiner.

C. The Rejection of Claims 33-34 and 37 under 35 U.S.C. § 103(a) as Being Unpatentable over U.S. Patent No. 6,024,699 to Surwit et al. ("Surwit") Is Improper

Claim 33 recites "defining a threshold event relating to both medical and nonmedical data about the patient, the threshold event defined by the patient" and "automatically provide an electronic notification, that is not an offer to have medical services performed, to a non health care provider selected by the patient upon occurrence of the threshold event". For example, the patient could define a threshold event as one where he overcomes illness and also has paid off his medical bills. The patient might desire to send an automatic notification to his favorite charity, after achieving overall good health and financial status, to inform the charity about his renewed ability to offer the charity more support.

The following are quotes from Surwit:

> "In view of the above discussion, it is an object of the present invention to allow health care providers to quickly and easily monitor many patients simultaneously and to automatically identify patients with medical conditions and to organize identified medical conditions by severity." 2:26-31.
>
> "Data transmitted from a patient monitoring system may be analyzed substantially simultaneously with the transmission thereof . . . to identify emergency medical conditions requiring immediate medical attention." 2:56.
>
> "In response to identifying an emergency medical condition, treatment information may be automatically communicated to the respective patient monitoring system . . . ." 4:8.
>
> "The present invention is advantageous because physicians and other health care providers can remotely monitor, identify, and treat patient medical problems . . . . The present invention facilitates automation of various aspects of patient treatment." 4:13-19.

Surwit deals exclusively with medical conditions in the monitoring, diagnosing, prioritizing, and treating of remotely located patients (Abstract).

Like the other patents, Surwit reflects entrenched thinking focused only on the needs of medical professionals and fails to accommodate the multidimensional needs of the powerless patient. First, Surwit discloses threshold events that deal exclusively with medical information (e.g., diabetes) because Surwit's sole focus is medical monitoring. Second, Surwit fails to teach my invention's claimed hybrid "threshold event relating to both medical and nonmedical data about the patient" because Surwit is focused on medical conditions only. Third, Surwit fails to teach any provision of a "notification . . . to a non health care provider" as selected by the patient because Surwit's sole focus is medical treatment and monitoring, limiting the scope of relevant notification recipients to those seeking medical help only.[6]

Question

Do Surwit's statements about automatic communication of information for health care management purposes teach or suggest the claim limitation of providing electronic notices to "a non health care provider selected by the patient", as alleged by the Examiner in the Final Action at 8, if I understand the allegation correctly (" . . . a patient must provide approval for communicating medical information to an outside [sic] approval")?

No. In its own words, Surwit states: "The present invention facilitates automation of various aspects of patient treatment, " (4:13-19) and "In response to identifying an emergency medical condition, treatment information may be automatically communicated to the respective patient monitoring system . . . " (4:8). Surwit's one-dimensional focus on medical monitoring inherently limits the potential pool of interested recipients to patients, and perhaps medical personnel. In complete contrast, my invention envisions a complex threshold event involving more than just medical data. My invention therefore also envisions a much larger pool of potential recipients, selected by the patient, who are interested in and will receive the complex threshold event.

Question

Does a patient's tacit agreement with medical professionals to monitor medical conditions of the patient somehow teach or suggest the claimed limitation "threshold event [to be] defined by the patient", as argued by the Examiner in the Final Action at page 8?

No. Passive patient approval of actions initiated by the medical organization still envisions a subservient role for the patient. Further, the transmission of data in the prior

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[6] Is the claimed invention similar to the well known alarm systems triggered by, for example, dead batteries or empty vending machines, as raised in the interview? No. In those systems, the alarms are automatically sent to technician professionals for repair or maintenance, not the consumer or people selected by the consumer. My invention is distinguished by the limitations "medical and nonmedical data", "event defined by the patient", "non health care provider selected by the patient".

> art, even if later approved by a patient, is initiated only if the organization desires it. In the prior art, the patient cannot actively initiate a certain transmission for her own personal reasons, whatever they may be, as my invention allows.

The Examiner has not made a prima facie showing of unpatentability. At page 13 of the Final Action, and perhaps with no better patent to cite, the Examiner again seems to argue that the rather amorphous knowledge of one of average skill in the art renders my claims unpatentable. In response, I question whether the inability of the Examiner to cite any specific prior art teaching, in a patent or elsewhere, is evidence of the nonobvious versatility of my invention in allowing the patient to define complex threshold events that trigger notifications to people designated by him outside the medical industry. Claim 33 is patentable. Claims 34 and 37 are also patentable at least for their dependence.

D. The Rejection of Claims 35-36 under 35 U.S.C. § 103(a) as Being Unpatentable over U.S. Patent No. 6,024,699 to Surwit et al. ("Surwit") and Further in View of U.S. Patent No. 6,208,974 to Campbell et al. ("Campbell") Is Improper

Claim 35 recites a notification sent upon a "threshold event [defined by the patient] relates to monetary amounts owed". Claim 36 further recites the recipient of the notification as "the interested entity is the patient". My claimed invention enables the patient to define when automated requests for payment are sent to non health care provider, including the "patient".

Paper number 9 at page 12 cites Campbell to reject these claims. Campbell states that a "central wellness plan administrator analyzes billing information uploaded from the hospitals and creates the files necessary to obtain payments from a client's bank account or credit card. Specifically, it creates payment files and submits them electronically to the bank." 30:65. The Campbell patent merely addresses conventional business-to-business communications and fails to enable a more multi-dimensional notification systems allowing definition of threshold events by non-business entities, such as patients. Following conventional industry practice, Campbell, like the other cited patents, fails to recognize the needs of the patient and her right to determine for herself when someone, perhaps even the patient himself, will be notified to make payments on her behalf, not when the health care organization chooses it. The cited patents describe simplistic threshold events based, not on patient preferences, but rather on a solitary factor: money (Campbell) or medical information (Surwit).

For these reasons, no showing of prima facie unpatentability has been made, and Claims 35, 36 are patentable.[7]

X. SUMMARY

The pending claims 21, 23-24, 27-28, and 30-44 have been improperly rejected. The Examiner has failed to make a prima facie case of unpatentability. I respectfully request reversal of the rejection of these claims.

[7] I must admit that Surwit and Campbell do come close to my invention as claimed in Claim 35-36. This is a close call.

APPENDIX
(PENDING CLAIMS)

21. A method for managing health care-related information about a patient as electronic records over a communications network comprising:

electronically handling the records as a plurality of component fields maintained in a database of a health care organization, each component field associated with a particular type of data associated with the patient;

determining access rules to selectively govern access to the component fields by both health care providers and non health care providers, the access rules determined by the patient;

applying the access rules before the component fields are accessed;

providing access based on the access rules to a first predetermined group of the component fields of the records when a first access parameter is present, the first access parameter relating to desired access by a first group of individuals, the providing access based on the access rules to the first predetermined group of the component fields including providing access to the first group of individuals, the first predetermined group of the component fields relating to a first medical condition of the patient;

providing access based on the access rules to a second predetermined group of the component fields of the records when a second access parameter different from the first access parameter is present, the second predetermined group of the component fields not identical to the first predetermined group of the component fields, the second access parameter relating to desired access by a second group of individuals not identical to the first group of individuals, the providing access based on the access rules to the second predetermined group of the component fields including providing access to the second group of individuals, the second predetermined group of the component fields relating to a second medical condition of the patient; and

completely denying to the second group of individuals access to at least a portion of the first predetermined group of the component fields of the records when the second access parameter is present.

23. The method of Claim 21 wherein the determining access rules includes considering a role of a person desiring access, the method further comprising evaluating a login identifier associated with the person, the login identifier associated with the role of the person.

24. The method of Claim 21 wherein:

the determining access rules includes considering a role of a person desiring access;

the first group of individuals includes a first health care provider having a first role;

the second group of individuals includes a second health care provider having a second role not identical to the first role;

the first predetermined group of the component fields is not all of the component fields and the second predetermined group of the component fields is not all of the component fields; and

the first predetermined group of the component fields is not identical to the second predetermined group of the component fields.

27. The method of Claim 21 wherein:

the second group of individuals includes a personal relation who is not a medical care provider of the patient; and

the second predetermined group of the component fields is a fraction of all of the component fields.

28. The method of Claim 21 wherein:

the second predetermined group of component fields is indicative of good health of the patient; and

the first predetermined group of component fields is indicative of bad health of the patient.

30. The method of Claim 21 wherein the determining access rules includes:

associating with one of the component fields permitted transactions selected from the group consisting of create, display, modify, and transmit, or any combination thereof;

associating with the one component field unpermitted transactions selected from the group consisting of create, display, modify, and transmit, or any combination thereof; and

restricting manipulation of the one component field to only the permitted transactions.

31. The method of Claim 21 further comprising:

selectively organizing the records or component fields thereof according to selectable parameters based at least in portion upon the particular types of patient data; and

compiling the organized records or component fields thereof into an electronic file history that is storable in the electronic database for later access.

32. The method of Claim 21 wherein the first group of individuals includes health care providers and the second group of individuals includes health care providers not included in the first group of individuals.

33. A method for handling health care-related records of a patient comprising:

enabling an electronic database to store the records;

defining a threshold event relating to both medical and nonmedical data about the patient, the threshold event defined by the patient;

programming the database or an associated computer with the threshold event;

analyzing the records stored in the database to determine if the threshold event has occurred; and

using the database or the associated computer to automatically provide an electronic notification, that is not an offer to have medical services performed, to a non health care provider selected by the patient upon occurrence of the threshold event as defined by the patient.

34. The method of Claim 33 wherein the records contain information received from various communications devices coupled to the database or the associated computer.

35. The method of Claim 33 wherein the threshold event relates to monetary amounts owed by the patient to a health care provider and wherein the electronic notification includes a request to make payments to the health care provider after services are performed.

36. The method of Claim 35 wherein the interested entity is the patient.

37. The method of Claim 33 wherein:

the threshold event relates to receipt by the database of an anticipated record;

the interested entity is a personal relation of the patient; and

the electronic notification includes at least a portion of the record.

38. A method for managing health care-related information about a patient as electronic records over a communications network comprising:

electronically handling the records as a plurality of component fields maintained in a database of a health care organization, each component field associated with a particular type of patient data associated with the patient;

determining access rules to selectively govern access to the component fields, the access rules determined at least in part by the patient;

applying the access rules before the component fields are accessed;

providing based on the access rules for a first group of individuals access to a first set of component fields of the records when a first access parameter is present, the first access parameter relating to desired access by the first group of individuals, the first set of component fields relating to a first condition of the patient;

providing based on the access rules for a second group of individuals not identical to the first group of individuals access to a second set of component fields of the records when a second access parameter not identical to the first access parameter is present, the second set of component fields not identical to the first set of component fields, the second access parameter relating to desired access by the second group of individuals, the second set of component fields relating to a second condition of the patient; and

denying to the second group of individuals access to at least a portion of the first set of component fields of the records.

39. The method of Claim 38 wherein the second condition relates to non-medical information about the patient.

40. The method of Claim 38 wherein the second group of individuals includes billing or accounting personnel and wherein the second set of component fields relates to financial information about the patient.

41. The method of Claim 40 wherein the first set of component fields includes information about medical health of the patient, the method further comprising denying the billing or accounting personnel access to any portion of the first set of component fields.

42. The method of Claim 38 wherein:

the first set of component fields satisfies a first criterion about monetary amounts owed by the patient; and

the second set of component fields satisfies a second criterion about monetary amounts owed by the patient.

43. The method of Claim 42 wherein:

the first group of individuals includes billing or accounting personnel; and

the second group of individuals includes personal relations of the patient.

44. The method of Claim 38 wherein:

the first set of component fields satisfies a first criterion about monetary amounts owed by the patient;

the second set of component fields relates to medical health of the patient.

the first group of individuals includes billing or accounting personnel; and

the second group of individuals includes health care providers.